

PATENT
10/023,407

D. REMARKS

Interview Summary

On September 3, 2004, Applicants' representative submitted an "Applicant Initiated Interview Form" to Examiner Barry Taylor via facsimile. Applicants' representative requested discussion of a proposed attached amendment to claim 1, 9, and 47.

On September 7, 2004 at 8:00 AM EST, an interview was conducted via telephone between Amy Pattillo, Applicants' Representative, and Examiner Barry Taylor. No exhibits were shown, nor demonstrations conducted.

Applicants' representative and the Examiner discussed claim 1, and in particular a proposed attached amendment to claim 1. Specifically, the prior art cited against claim 1 is the US Patent to Swope et al. (U.S. Patent 6,639,977 hereinafter Swope) in view of Bauer et al (US Patent 5,859,900 hereinafter Bauer).

In particular, Applicant's representative proposed an amendment in advance to add an additional element to claim 1 of receiving the destination telephone number without requiring a caller at said origin device to first enter an additional access number for a telephony accessible reverse billing service to distinguish claim 1 from Swope and Bauer's systems which require a caller to first enter telephone number that dials into a reverse billing service. The Examiner pointed out that this additional element reads on other types of phone systems, such as PBX systems. In addition, the Examiner requested that Applicants' representative clarify how the reverse billing would happen if the caller does not request the service. Examiner Taylor suggested that the claim should clarify how the reverse billing is requested and may need to focus on the voice authentication aspect. Applicants' representative agreed to consider additional amendments which would clarify the claim. In conclusion, no agreement with respect to the claims was reached. Applicants are filing this response with the amended claims for further review by the Examiner.

With respect to the proposed amendment to claims 9 and 47, Applicants' representative and Examiner Taylor discussed whether the proposed amendment may place these claims into

AUS920010839US1

18

PATENT
10/023,407

group II of the restriction placed by Examiner Taylor in a previous action; Examiner Taylor requested additional time to consult with a supervisor about the effects of amending claims to include art previously restricted into group II. In addition, Examiner Taylor clarified that he interpreted an "order" to include a collect call. In conclusion, no agreement with respect to the claims was reached. Applicants are filing this response with the amended claims for further review by the Examiner.

35 USC § 103(a)

Claims 1-5, 7, 9-14, 16, 18-23, 25, 27-29, 31-32, 34-35

Next, claims 1-5, 7, 9-14, 16, 18-23, 25, 27-29, 31-32, and 34-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swope in view of Bauer et al (US Patent Number 5,859,900 hereinafter Bauer).

Claims 1, 10, 19, 28, 31, and 34

The Examiner cites Swope as teaching the elements of claim 1, except that while Swope discloses "that telephone service billed to the callee (i.e. called party) is accessible at a plurality of destination devices (see col. 2, lines 52-55)", Swope does not "first" authenticate an identity of the called party using a voice utterance (see Applicants' remarks on page 22, second to last paragraph, wherein Applicants' contend that Swope does not "first" determine the identity of a called party before providing alternate billing, of paper number 8, dated 3/24/04)." [Office Action, p. 4] However, the Examiner notes that Swope indeed verifies the called party by using voice recognition in Swope col. 8, lines 6-7. [Office Action, p. 4] The Examiner cites Bauer as also teaching "a system and method for reverse billing wherein the called party verified either before or after receipt of call (col. 2, lines 1-3) providing the called party the ability to terminate without charge (col. 2 lines 18-21, col. 6, lines 24-27). [Office Action, p. 4] The Examiner concludes that "it would have been obvious to one of ordinary skill in the art at the time of invention to modify the invention as taught by Swope to first verify if called party will accept the

AUS920010839US1

19

PATENT
10/023,407

telephone call as taught by Bauer for the benefit of allowing the called party the ability to terminate the telephone call without being charged.” [Office Action, p. 4]

Claim 1 currently reads as follows:

1.(Currently Twice Amended) A method for billing for telephone services, said method comprising:

receiving, from an origin device, a destination line number for processing a call;

loading a profile for a line subscriber of said destination line number, wherein said profile comprises a line subscriber billing plan for said destination line number; and

responsive to detecting an answer to said call at a destination device accessible via said destination line number, authenticating an identity of a callee receiving said call through a voice utterance provided by said callee;

responsive to detecting a request initiated by said callee to receive billing for said telephone service provided for said call, replacing said line subscriber billing plan with a callee billing plan accessed according to said authenticated identity of said callee, such that said call is processed according to said callee billing plan based on a callee initiated request for reversed billing to said callee.

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Furthermore, in a 103(a) inquiry, a prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention.

AUS920010839US1

20

PATENT
10/023,407

W.L Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983, *cert. denied*, 469 U.S. 851 (1984)). Applicants submit that Swope in view of Bauer does not teach or suggest all the claim limitations of twice amended claim 1. Applicants have amended claim 1 to clarify which party is performing the request for billing to pass to the callee. In particular, claim 1 now clarifies that the callee answering a call initiates reverse billing to the callee's account. Swope and Bauer both describe systems where the caller is first required to request the reverse billing service by dialing a number to access a reverse billing service provider and then the callee must agree to accept billing for the call. In contrast, claim 1 now clarifies that the callee answering the call initiates the request for billing for the telephone service provided for the call to pass to the callee. Thus, Applicants submit that Swope in view of Bauer does not teach or suggest the claim limitation of a callee initiated reverse billing system. In addition, Applicants assert that when Swope and Bauer are considered in their entirety, the requirement of a caller initiating the reverse billing by calling into a reverse billing service teaches away from a callee initiated reverse billing system.

Applicants note that system claim 10 and program claim 19, which correspond to method claim 1, are amended in a similar manner as claim 1. Therefore, Applicants respectfully request allowance of claims 10 and 19 with the allowance of claim 1.

In addition, Applicants note that method, system, and program claims 28, 31, and 34 are amended in a similar manner as claim 1. Therefore, Applicants respectfully request allowance of claims 28, 31, and 34 with the allowance of claim 1.

Claims 2, 11, and 20

Applicants note that claims 2, 11, and 20 are dependent upon independent claims 1, 10, and 19, which are amended towards allowance. Therefore, Applicants respectfully request allowance of dependent claims 2, 11, and 20 with the allowance of independent claims 1, 10 and 19. In addition, however, Applicants amend claims 2, 11 and 20 to clarify that claims 2, 11 and 20 are not obvious, and request allowance of amended claims 2, 11, and 20 as not obvious in view of Swope in view of Bauer.

AUS920010839US1

21

PATENT
10/023,407

The Examiner cites Swope, col. 8, lines 6-7 as teaching "using voice recognition of called party." [Office Action, p. 5] Swope col. 8, lines 6-7 is a dependent claim which specifically reads: "wherein the CIV includes voice recognition of the called party." The CIV is defined within Swope col. 1, lines 33-34 as a Customer Identification and Verification, such as a Personal Identification Number (PIN).

Claim 2 currently reads as follows:

2. **(Currently Amended)** The method for billing for telephone services according to claim 1, wherein authenticating an identity of a callee further comprises:

authenticating said identity of said callee ~~according to~~ by matching a voice utterance provided by said callee with a previously recorded voice utterance by said callee.

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Swope describes customer identification and verification through voice recognition. Voice recognition is a term of art which is typically limited to the recognition of the text spoken through a voice; if the text spoken through a voice matches a password, then the user is verified for access. For example, in Swope, a caller may speak a personal identification number. In contrast, as clarified in the amended claim, identity authentication through matching a voice utterance with a previously recorded voice utterance is a form of biometric identification that verifies the identity of the speaker by matching a unique characteristic of that person. The specification of the present invention describes voice authentication as: "An authentication service within telco application server 22 may include identification and verification of the identity of a caller and/or callee of a particular call. Such a service may require that subscribers provide voice samples when setting up a subscription. The

AUS920010839US1

22

PATENT
10/023,407

stored voice samples may then be compared against voice samples received for a particular call in order to authenticate the identity of a current caller or callee of the particular call.”

(Description, p. 16, lines 20-27) Thus, Applicants submit that Swope does not teach or suggest the amended claim limitation of voice based identity authentication.

Applicants note that dependent system claim 11 and dependent program claim 20, which correspond to dependent method claim 2, are amended in a similar manner as claim 2. Therefore, Applicants respectfully request allowance of claims 11 and 20 with the allowance of claim 2.

Claims 9, 18, and 27

Applicants note that claims 9, 18, and 27 are dependent upon independent claims 1, 10, and 19, which are amended towards allowance. Therefore, Applicants respectfully request allowance of dependent claims 9, 18, and 27 with the allowance of independent claims 1, 10 and 19. In addition, however, Applicants respectfully submit that claims 9, 18 and 27 are not obvious under Swope in view of Bauer, and therefore should be allowed.

The Examiner cites Swope as teaching “billing the callee (see col. 3, lines 6-10 wherein called party gives approval) for an order (see col. 3 lines 6-10 wherein called party approves the order (i.e. collect call) may be billed to another account associated with called party).” [Office Action, p. 5] Swope col. 3, lines 6-10 read: “...upon approval of the called party, reverse the billing of the telephone call so that it is deducted from an account owned and maintained by the called party other than the account associated with the destination number.” The Examiner interprets the scope of “order” to include a collect call that may be billed to another account associated with the called party. [Office Action, p. 5]

Claim 9 currently reads:

9. (Original) The method for billing for telephone services according to claim 1, further comprising:

AUS920010839US1

23

PATENT
10/023,407

billing said callee for an order placed with a caller at said origin device according to said callee billing plan.

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully propose that Swope does not teach or suggest the invention of claim 9 because Swope does not teach billing the callee for an order placed with a caller. Applicants note that Swope only teaches enabling a callee to agree to the request for the callee to accept charges for a collect call, which is a telephone service. An agreement by a callee to receive charges for a call initiated by the caller is not an order placed by the callee with the caller. In particular, Applicants respectfully assert that first, claim 1 teaches enabling the callee to initiate the reverse billing for the telephone service; a request for billing of telephone service is placed with a telephone service provider, not a caller. Then, claim 2 teaches enabling the callee to also be billed for orders that the callee places with the caller according to the callee's billing plan. Thus, Applicants submit that Swope does not teach or suggest the claim limitation of billing a callee for an order placed with a caller. Therefore, Applicants respectfully propose that the Examiner does not meet the burden of showing prima facie obviousness of making the combination because the claimed invention is not taught by combining the references.

Claims 3-5, 7, 12-14, 16, 21-23, 27, 29, 32, and 35

Claims 3-5, 7, 12-14, 16, 21-23, 27, 29, 32, and 35 stand rejected as method, system and program claims that are dependent upon independent method, system, and program claims 1, 10, 19, 28, 31, and 34. Applicants respectfully propose that since claims 1, 10, 19, 28, 31, and 34 are amended towards allowance, dependent claims 3-5, 7, 12-14, 16, 21-23, 27, 29, 32, and 35 should also be allowed.

AUS920010839US1

24

PATENT
10/023,407

Claims 6, 15, 24, 30, 33, 36

Claims 6, 15, 24, 30, 33, and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swope in view of Bauer and further in view of Reto et al (US Patent 5,825,857). Applicants first note the above proposition that amended claims 1, 10, 19, 28, 31, and 34 are not obvious under Swope in view of Bauer, and therefore as dependent claims of allowable subject matter, claims 6, 15, 24, 30, 33, and 36 should also be allowed.

Claims 8, 17, 26, 47-48, 51-52

Next, claims 8, 17, 26, 47-48, 51-52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swope in view of Bauer and further in view of Kamil (US Patent 4,706,275). Applicants first note the above proposition that claims 1, 12, and 23 are not taught by Swope, and therefore as a dependent claims of independent claims amended towards allowance, claims 8, 17, and 26 should also be allowed. In addition, Applicants note that claims 47 and 48 are listed as rejected for the same reasons as claims 8, 17, and 26, but no specific grounds for the rejection of the elements of claims 47 and 48 are provided.

Claims 47 and 48 currently read:

47.(Original) A method for controlling billing transactions, comprising:

receiving a billing request from a caller during a call, wherein said billing request comprises an authenticated callee identity and callee account provider identifier; and

accessing payment for said billing request from said callee account provider according to said authenticated callee identity.

48.(Original) The method for controlling billing transactions according to claim 47, further comprising:

AUS920010839US1

25

PATENT
10/023,407

transferring said payment to a caller account provider according to an authenticated caller identity.

With reference to claims 8, 17, 26, and 47-48, the Examiner cites Swope as teaching (1) receiving, from the calling device, a destination line number for processing a call (col. 3, lines 5-6); (2) loading a profile for a line subscriber of the destination line where the profile comprises a line subscriber billing plan for the destination line number; (3) response to detecting an answer to the call at a destination device accessible via the destination line number, authenticating an identity of a callee receiving the call; and (4) replacing the line subscriber billing plan with a callee billing plan associated with the authenticated identity of the callee, such that the callee is billed for service requested by the called party for the call. (col. 3, lines 5-15). [Office Action, p. 7-8] Further, the Examiner cites Swope as disclosing that the "telephone service billed to the callee is accessible at a plurality of destination devices. (col. 1, lines 52-55)" [Office Action, p. 8] However, the Examiner notes that Swope in view of Bauer fails to show routing a call to a service provider associated with the destination number. [Office Action, p. 8] Kamil, however, teaches "using a special exchange owned by the service provider. After dialing the exchange the caller is prompted for identifying code and the called number he wants to call. Once caller validated the special exchange decrements the subscriber's balance as the telephone progresses. In other words, Kamil provides special exchange enabling for prepayment for telephony calls which can be made from any telephone or from dedicated public telephone (col. 6, lines 6-8). [Office Action, p. 8-9] Thus, the Examiner concludes that "it would have been obvious for any one of ordinary skill in the art at the time of invention to modify the invention as taught by Swope in view of Bauer to use a special exchange as taught by Kamil for the benefit of having the service provider own and control the special exchange thereby allowing any telephone to be used when making the call." [Office Action, p. 9]

With regard to claim 47, where the Examiner cites Swope as teaching (4) "replacing line subscriber billing plan with a callee billing plan associated with the authenticated identity of the

AUS920010839US1

26

PATENT
10/023,407

callee, such that the callee is billed for service requested by the called party for the call”, the rejection lacks a specific object to the elements of claim 47. In particular, the rejection does not identify how Swope teaches (a) receiving a billing request that comprises an authenticated callee identity and callee account provider identifier or (b) accessing payment for the billing request according to the authenticated callee identity.

With regard to claim 48, the invention teaches transferring a payment to a caller account provider. Neither Swope nor Kamil teach transferring a payment to a caller account provider. Further, the Examiner does not point out where Swope or Kamil teach transferring a payment to a caller account provider.

Therefore, Applicants respectfully propose that the Examiner does not meet the burden of showing the obviousness of making the combination for claims 47 and 48 because the Examiner does not specifically point out how the claimed invention is taught by the references and because the claimed invention is not taught by combining the references.

With regard to claims 51 and 52, Applicants note that these are claims that are dependent upon independent claim 47. Applicants respectfully note that the Examiner does not prove prima facie obviousness for claim 47 and therefore does not prove prima facie evidence for dependent claims 51 and 52.

Claim 49

Claim 49 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Swope in view of Kamil et al (US Patent Number 4, 706, 275) and further in view of O’Neil (US Patent Number 6,226,977). Applicants first note the above proposition that claim 47 is not taught by Swope, and therefore as a dependent claim of allowable subject matter, claim 49 should also be allowed. In addition, Applicants note that claim 49 is not obvious in view of Swope, Kamil and O’Neil, and therefore should be allowed.

The Examiner cites Swope in view of Kamil as not showing a “request for a fund transfer.” [Office Action, p. 10] The Examiner cites O’Neil, however, as teaching “a method and system for providing prepaid and credit-limited telephone services wherein an

AUS920010839US1

27

PATENT
10/023,407

announcement is played to the originating station or to the terminating station indicating that the credit limit has been exceeded (col. 5, lines 52-62, col. 15, lines 27-37). In response, an alternate payment source, such as credit or debit bank account, may be received for continuing the communication, and the cost associated with continuing the communication may be charged to the alternate payment source.” [Office Action, p. 10] Thus, the Examiner concludes that “it would have been obvious for any one of ordinary skill in the art at the time of invention to modify the invention as taught by Swope in view of Kamil to use announcement as taught by O’Neil for the benefit of prompting the originating and terminating device for an alternate payment source so that communication may continue.” [Office Action, p. 10]

Claim 49 currently reads:

49.(Original) The method for controlling billing transactions according to claim 47, wherein said billing request comprises a request for a fund transfer from said callee to said caller.

In establishing a *prima facie* case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). The Examiner cites the combined references as teaching an announcement used for the benefit of prompting the originating and terminating device for an alternate payment source so that communication may continue. Even if the combined references provide the announcement teaching cited by the Examiner, the billing request taught in claim 49 is not an announcement requesting an alternate payment source for a call to continue, but a request to a billing service for a fund transfer from the callee to the caller. Thus, Applicants respectfully note that the Examiner does not show how the combined references teach or suggest a billing request for a fund transfer as taught by claim 49 in view of 47, where the billing request includes a callee identity and callee account provider identifier and does not teach or suggest the limitation of an announcement broadcast to the originating and terminating device for an alternate payment source so that communication may continue.

AUS920010839US1

28

PATENT
10/023,407

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, Applicants are not under an obligation to submit evidence of nonobviousness. As previously described, Applicants respectfully propose that the Examiner has not met the burden of establishing prima facie obviousness for claim 49 because the Examiner does not show how Swope in view of Kamil and O'Neil teaches or suggests a billing request for a fund transfer from the callee to the caller.

Claim 50

Claim 50 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Swope in view of Kamil et al (US Patent Number 4, 706, 275) and further in view of Block (US Patent Number 5,960,416). Applicants note the above proposition that claim 47 is not obvious under Swope in view of Bauer and Kamil, and therefore as a dependent claim of allowable subject matter, claim 50 should also be allowed.

Claims 1-5, 7, 9-14, 16, 18-23, 25, 27-29, 31-32, 34-35

Next, claims 1-5, 7, 9-14, 16, 18-23, 25, 27-29, 31-32, and 34-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swope in view of Infosino (6,327,346).

Claims 1, 10, 19, 28, 31, and 34

Regarding claim 1, the Examiner notes that Swope does not teach "first" authenticating an identity of the called party using a voice utterance. [Office Action, p. 13] The Examiner cites Infosino, however, as teaching a "method and apparatus for setting user communication parameters wherein voice identification of users are used to setup customized services (abstract). For example, a sample voice pattern of each user using party device (see calling device 100 and called device 120 in Figure 1) is stored so that when one or more persons are using particular device the communication parameters or device settings are changed via recognizing voice sample (col. 1 lines 13-54)." [Office Action, p. 13] The Examiner notes that "of course, Infosino discloses verifying called party when call made to the called party terminal (see col. 4

AUS920010839US1

PATENT
10/023,407

lines 26-34 wherein activation of user device 100 may be performed when attempting to establish communication with user device 120 or when receiving communication attempt from the user device)." [Office Action, pp 13-14] The Examiner summarizes that "Infosino uses voices utterance to enable/disable services available to users using devices 100 and 120 shown in figure 1." Then, the Examiner concludes that "it would have been obvious for any one of ordinary skill in the art at the time of invention to modify the invention as taught by Swope to use voice utterance as taught by Infosino for the benefit of providing customized service based on an identity of user as taught by Infosino (col. 1 lines 21-22).

First, Applicants assert that claim 1 has been amended to overcome any obviousness under Swope in view of Infosino. In particular, claim 1 now clarifies that the callee answering a call initiates reverse billing to the callee's account. Swope describes a system where the caller is first required to request the reverse billing service by dialing a number to access a reverse billing service provider and then the callee must agree to accept billing for the call. In contrast, claim 1 now clarifies that the callee answering the call initiates the request for billing for the telephone service provided for the call to pass to the callee. Infosino does not teach callee initiated reverse billing. Thus, Applicants submit that Swope in view of Infosino does not teach or suggest the claim limitation of a callee initiated reverse billing system.

Applicants note that system claim 10 and program claim 19, which correspond to method claim 1, are amended in a similar manner as claim 1. Therefore, Applicants respectfully request allowance of claims 10 and 19 with the allowance of claim 1.

In addition, Applicants note that method, system, and program claims 28, 31, and 34 are amended in a similar manner as claim 1. Therefore, Applicants respectfully request allowance of claims 28, 31, and 34 with the allowance of claim 1.

Claims 2, 11, and 20

Applicants note that claims 2, 11, and 20 are dependent upon independent claims 1, 10, and 19, which are amended towards allowance. Therefore, Applicants respectfully request allowance of dependent claims 2, 11, and 20 with the allowance of independent claims 1, 10 and

AUS920010839US1

30

PATENT
10/023,407

19. In addition, however, Applicants amend claims 2, 11 and 20 to clarify that claims 2, 11 and 20 are not obvious, and request allowance of amended claims 2, 11, and 20 as not obvious under Swope in view of Infosino.

The Examiner cites Swope, col. 8, lines 6-7 as teaching "using voice recognition of called party." [Office Action, p. 14] Swope col. 8, lines 6-7 is a dependent claim which specifically reads: "wherein the CIV includes voice recognition of the called party." The CIV is defined within Swope col. 1, lines 33-34 as a Customer Identification and Verification, such as a Personal Identification Number (PIN).

Claim 2 currently reads as follows:

2. **(Currently Amended)** The method for billing for telephone services according to claim 1, wherein authenticating an identity of a callee further comprises:

authenticating said identity of said callee ~~according to~~ by matching a voice utterance provided by said callee with a previously recorded voice utterance by said callee.

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Swope describes customer identification and verification through voice recognition. Voice recognition is a term of art which is typically limited to the recognition of the text spoken through a voice; if the text spoken through a voice matches a password, then the user is verified for access. For example, in Swope, a caller may speak a personal identification number. In contrast, as clarified in the amended claim, identity authentication through matching a voice utterance with a previously recorded voice utterance is a form of biometric identification that verifies the identity of the speaker by matching a unique characteristic of that person. The specification of the present invention describes voice authentication as: "An authentication service within telco application server 22 may include

AUS920010839US1

31

PATENT
10/023,407

identification and verification of the identity of a caller and/or callee of a particular call. Such a service may require that subscribers provide voice samples when setting up a subscription. The stored voice samples may then be compared against voice samples received for a particular call in order to authenticate the identity of a current caller or callee of the particular call.”

(Description, p. 16, lines 20-27) Thus, Applicants submit that Swope does not teach or suggest the amended claim limitation of voice based identity authentication.

Applicants note that dependent system claim 11 and dependent program claim 20, which correspond to dependent method claim 2, are amended in a similar manner as claim 2.

Therefore, Applicants respectfully request allowance of claims 11 and 20 with the allowance of claim 2.

Claims 9, 18, and 27

Applicants note that claims 9, 18, and 27 are dependent upon independent claims 1, 10, and 19, which are amended towards allowance. Therefore, Applicants respectfully request allowance of dependent claims 9, 18, and 27 with the allowance of independent claims 1, 10 and 19. In addition, however, Applicants respectfully submit that claims 9, 18 and 27 are not obvious under Swope in view of Infosino, and therefore should be allowed.

The Examiner cites Swope as teaching “billing the callee (see col. 3, lines 6-10 wherein called party gives approval) for an order (see col. 3 lines 6-10 wherein called party approves the order (i.e. collect call) may be billed to another account associated with called party).” [Office Action, p. 15] Swope col. 3, lines 6-10 read: “...upon approval of the called party, reverse the billing of the telephone call so that it is deducted from an account owned and maintained by the called party other than the account associated with the destination number.” The Examiner interprets the scope of “order” to include a collect call that may be billed to another account associated with the called party. [Office Action, p. 15]

AUS920010839US1

32

PATENT
10/023,407

Claim 9 currently reads:

9. (Original) The method for billing for telephone services according to claim 1, further comprising:

billing said callee for an order placed with a caller at said origin device according to said callee billing plan.

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully propose that Swope does not teach or suggest the invention of claim 9 because Swope does not teach billing the callee for an order placed with a caller. Applicants note that Swope only teaches enabling a callee to agree to the request for the callee to accept charges for a collect call, which is a telephone service. An agreement by a callee to receive charges for a call initiated by the caller is not an order placed by the callee with the caller. In particular, Applicants respectfully assert that first, claim 1 teaches enabling the callee to initiate the reverse billing for the telephone service; a request for billing of telephone service is placed with a telephone service provider, not a caller. Then, claim 2 teaches enabling the callee to also be billed for orders that the callee places with the caller according to the callee's billing plan. Thus, Applicants submit that Swope does not teach or suggest the claim limitation of billing a callee for an order placed with a caller. Therefore, Applicants respectfully propose that the Examiner does not meet the burden of showing prima facie obviousness of making the combination because the claimed invention is not taught by combining the references.

Claims 3-5, 7, 12-14, 16, 21-23, 27, 29, 32, and 35

Claims 3-5, 7, 12-14, 16, 21-23, 27, 29, 32, and 35 stand rejected as method, system and program claims that are dependent upon independent method, system, and program claims 1, 10, 19, 28, 31, and 34. Applicants respectfully propose that since claims 1, 10, 19, 28, 31, and 34

AUS920010839US1

33

PATENT
10/023,407

are amended towards allowance, dependent claims 3-5, 7, 12-14, 16, 21-23, 27, 29, 32, and 35 should also be allowed.

Claims 6, 15, 24, 30, 33, 36

Claims 6, 15, 24, 30, 33, and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swope in view of Infosino and further in view of Reto et al (US Patent 5,825,857). [Office Action, p. 15] Applicants first note the above proposition that amended claims 1, 10, 19, 28, 31, and 34 are not obvious under Swope in view of Infosino, and therefore as dependent claims of allowable subject matter, claims 6, 15, 24, 30, 33, and 36 should also be allowed.

Claims 8, 17, 26, 47-48, 51-52

Next, claims 8, 17, 26, 47-48, 51-52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swope in view of Infosino and further in view of Kamil (US Patent 4,706,275). Applicants first note the above proposition that claims 1, 12, and 23 are not taught by Swope in view of Infosino, and therefore as a dependent claims of independent claims amended towards allowance, claims 8, 17, and 26 should also be allowed. In addition, Applicants note that claims 47 and 48 are listed as rejected for the same reasons as claims 8, 17, and 26, but no specific grounds for the rejection of the elements of claims 47 and 48 are provided.

Claims 47 and 48 currently read:

47. (Original) A method for controlling billing transactions, comprising:

receiving a billing request from a caller during a call, wherein said billing request comprises an authenticated callee identity and callee account provider identifier; and

AUS920010839US1

34

PATENT
10/023,407

accessing payment for said billing request from said callee account provider according to said authenticated callee identity.

48. (Original) The method for controlling billing transactions according to claim 47, further comprising:

transferring said payment to a caller account provider according to an authenticated caller identity.

With reference to claims 8, 17, 26, and 47-48, the Examiner cites Swope as teaching (1) receiving, from the calling device, a destination line number for processing a call (col. 3, lines 5-6); (2) loading a profile for a line subscriber of the destination line where the profile comprises a line subscriber billing plan for the destination line number; (3) response to detecting an answer to the call at a destination device accessible via the destination line number, authenticating an identity of a callee receiving the call; and (4) replacing the line subscriber billing plan with a callee billing plan associated with the authenticated identity of the callee, such that the callee is billed for service requested by the called party for the call. (col. 3, lines 5-15). [Office Action, pp. 16-17] Further, the Examiner cites Swope as disclosing that the "telephone service billed to the callee is accessible at a plurality of destination devices. (col. 1, lines 52-55)" [Office Action, p. 17] The Examiner then notes that Infosino teaches a "method and apparatus for setting user communication parameters wherein voice identification of users are used to setup customized services (abstract). For example, a sample voice pattern of each user using particular device (see calling device 100 and called device 120 figure 1) is stored so that when one or more persons are using particular device the communication parameters or device settings are changed via recognizing voice sample (col. 1 lines 13-54). Of course, Infosino discloses verifying called party when call made to the called party terminal. In other words, Infosino uses voice utterance to enable/disable services available to users using devices 100 and 120 shown in figure 1." [Office Action pp. 17-18] However, the Examiner notes that Swope in view of Infosino fails to

AUS920010839US1

35

PATENT
10/023,407

show routing a call to a service provider associated with the destination number. [Office Action, p. 18] Kamil, however, teaches “using a special exchange owned by the service provider. After dialing the exchange the caller is prompted for identifying code and the called number he wants to call. Once caller validated the special exchange decrements the subscriber’s balance as the telephone progresses. In other words, Kamil provides special exchange enabling for prepayment for telephony calls which can be made from any telephone or from dedicated public telephone (col. 6, lines 6-8). [Office Action, p. 18] Thus, the Examiner concludes that “it would have been obvious for any one of ordinary skill in the art at the time of invention to modify the invention as taught by Swope in view of Infosino to use a special exchange as taught by Kamil for the benefit of having the service provider own and control the special exchange thereby allowing any telephone to be used when making the call.” [Office Action, pp. 18-19]

With regard to claim 47, where the Examiner cites Swope as teaching (4) “replacing line subscriber billing plan with a callee billing plan associated with the authenticated identity of the callee, such that the callee is billed for service requested by the called party for the call”, the rejection lacks a specific object to the elements of claim 47. In particular, the rejection does not identify how Swope teaches (a) receiving a billing request that comprises an authenticated callee identity and callee account provider identifier or (b) accessing payment for the billing request according to the authenticated callee identity.

With regard to claim 48, the invention teaches transferring a payment to a caller account provider. Neither Swope nor Infosino nor Kamil teach transferring a payment to a caller account provider. Further, the Examiner does not point out where Swope, Infosino, or Kamil teach transferring a payment to a caller account provider.

Therefore, Applicants respectfully propose that the Examiner does not meet the burden of showing the obviousness of making the combination for claims 47 and 48 because the Examiner does not specifically point out how the claimed invention is taught by the references and because the claimed invention is not taught by combining the references.

With regard to claims 51 and 52, Applicants note that these are claims that are dependent upon independent claim 47. Applicants respectfully note that the Examiner does not prove prima

AUS920010839US1

36

PATENT
10/023,407

facie obviousness for claim 47 and therefore does not prove prima facie evidence for dependent claims 51 and 52.

Claim 49

Claim 49 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Swope in view of Infosino and Kamil et al (US Patent Number 4, 706, 275) and further in view of O'Neil (US Patent Number 6,226,977). Applicants first note the above proposition that claim 47 is not taught by Swope in view of Infosino, and therefore as a dependent claim of allowable subject matter, claim 49 should also be allowed. In addition, Applicants note that claim 49 is not obvious in view of Swope, Infosino, Kamil and O'Neil, and therefore should be allowed.

The Examiner cites Swope in view of Infosino and Kamil as not showing a "request for a fund transfer." [Office Action, p. 20] The Examiner cites O'Neil, however, as teaching "a method and system for providing prepaid and credit-limited telephone services wherein an announcement is played to the originating station or to the terminating station indicating that the credit limit has been exceeded (col. 5, lines 52-62, col. 15, lines 27-37). In response, an alternate payment source, such as credit or debit bank account, may be received for continuing the communication, and the cost associated with continuing the communication may be charged to the alternate payment source." [Office Action, p. 20] Thus, the Examiner concludes that "it would have been obvious for any one of ordinary skill in the art at the time of invention to modify the invention as taught by Swope in view of Infosino and Kamil to use announcement as taught by O'Neil for the benefit of prompting the originating and terminating device for an alternate payment source so that communication may continue." [Office Action, p. 20]

Claim 49 currently reads:

49. (Original) The method for controlling billing transactions according to claim 47, wherein said billing request comprises a request for a fund transfer from said callee to said caller.

AUS920010839US1

37

PATENT
10/023,407

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). The Examiner cites the combined references as teaching an announcement used for the benefit of prompting the originating and terminating device for an alternate payment source so that communication may continue. Even if the combined references provide the announcement teaching cited by the Examiner, the billing request taught in claim 49 is not an announcement requesting an alternate payment source for a call to continue, but a request to a billing service for a fund transfer from the callee to the caller. Thus, Applicants respectfully note that the Examiner does not show how the combined references teach or suggest a billing request for a fund transfer as taught by claim 49 in view of 47, where the billing request includes a callee identity and callee account provider identifier and does not teach or suggest the limitation of an announcement broadcast to the originating and terminating device for an alternate payment source so that communication may continue.

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, Applicants are not under an obligation to submit evidence of nonobviousness. As previously described, Applicants respectfully propose that the Examiner has not met the burden of establishing prima facie obviousness for claim 49 because the Examiner does not show how Swope in view of Infosino and Kamil and further in view of O'Neil teaches or suggests a billing request for a fund transfer from the callee to the caller.

Claim 50

Claim 50 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Swope in view of Infosino and Kamil et al (US Patent Number 4, 706, 275) and further in view of Block (US Patent Number 5,960,416). Applicants note the above proposition that claim 47 is not obvious under Swope in view of Infosino and Kamil, and therefore as a dependent claim of allowable subject matter, claim 50 should also be allowed.

AUS920010839US1

38

PATENT
10/023,407

Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims are respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Amy J. Pattillo", with a long horizontal flourish extending to the right.

Amy J. Pattillo
Attorney for Applicants
Registration No. 46,983
(512) 402-9820

AUS920010839US1

39